



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/518,190

12/16/2004

Hans Rainer Willmen

P / 37 - 181

5572

2352 7590 01/17/2007
OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 100368403

EXAMINER

WOODALL, NICHOLAS W

ART UNIT

PAPER NUMBER

3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

3 MONTHS

01/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/518,190

Applicant(s)

WILLMEN, HANS RAINER

Examiner

Nicholas Woodall

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-15 is/are allowed.
- 6) ☒ Claim(s) 1,2,6,7 and 10 is/are rejected.
- 7) ☒ Claim(s) 3-5,8 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/16/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's amendment received on 10/26/2006.

Drawings

2. In the office action mailed on 07/24/2006, the examiner objected to the drawings for not showing the screw as mentioned in claim 10. The examiner is hereby withdrawing the objection to the drawings because the applicant has removed the language pertaining to the screw from claim 10.

Information Disclosure Statement

3. In the office action mailed on 07/24/2006, the examiner did not consider the references listed on information disclosure statement filed by the applicant on 12/16/2004 because the office had not received legible copies of the foreign references cited therein. The office has received legible copies of the foreign references and the information disclosure statement has been considered.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tabor (U.S. 3,710,674) in view of West JR (U.S. Publication 2003/0074002).

Art Unit: 3733

Regarding claim 1, Tabor discloses a device having a circular cross-section that is conically shaped on the outside and tapers from a head part to a base part of the device. The device further comprises a through-hole along the length of the dowel. The device further comprises a continuous longitudinal slit that provides a continuous C-shaped cross-section of the dowel. The head part of the device is comprised of a flange integrally formed onto the device. Tabor further discloses the device to comprise a bevel in the area of the longitudinal slit that decreases from the head part inward. Tabor fails to disclose the head part of the device also including a bevel. West JR teaches of an anchor device wherein the head of the device comprises a beveled surface that extends from the head part inward in order to enable the device to lay substantially flush with the exterior surface of the bone that the device is inserted into (page 4 paragraph 46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Tabor to further include a bevel on the head part of the device in view of West JR in order to enable the device to lay substantially flush with the exterior surface of the bone that the device is inserted into.

Further regarding claim 1, the combination of Tabor and West JR disclose the invention as claimed except for the bore having a uniform cross-section along the entire length of the device, it is noted that it would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the device of Tabor modified by West JR with a uniform bore, since applicant has not disclosed that such solve any stated problem or is

Art Unit: 3733

anything than one of numerous shapes or configurations a person ordinary with ordinary skill in the art would find obvious the purpose of providing a uniform bore in the device. In re Dailey and Eilers, 149 USPQ 47 (1966).

6. Claims 1, 2, 6, 7, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabor (U.S. 3,710,674) in view of West JR (U.S. Publication 2003/0074002) further in view of Overaker (U.S. Patent 6,942,666).

Regarding claims 1, 2, 6, 7, and 10, the combination of Tabor and West JR disclose the invention as claimed except for the head of the device having a countersink, conically shaped annular ribs on the outer surface that are designed with sharp edges, steep flanks directed towards the head of the device and gentle flanks directed towards the base of the device that extend as far as the steep flank of the next annular rib and are spaced axially along the length of the device, and the device being manufactured from an absorbable material. Overaker teaches a device wherein the head part of the device includes a countersink, the device further comprising conically shaped annular ribs on the outer surface that are designed with sharp edges, steep flanks directed towards the head of the device and gentle flanks directed towards the base of the device that extend as far as the steep flank of the next annular rib and are spaced axially along the length of the device, and the device being manufactured from an absorbable material such as glass or ceramic (column 6 lines 66-67 and column 7 lines 1-32) in order to serve as a receiving surface for the insertion of an expander member (column 3 lines 4-11), for engaging the bone tissue within a bone opening (column 3 lines 18-25), and to act as a therapeutic agent release

Art Unit: 3733

matrix (column 6 lines 62-67, column 7 lines 1-67, and column 8 lines 1-16). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Tabor modified by West JR with the head of the device having a countersink, conically shaped annular ribs on the outer surface that are designed with sharp edges, steep flanks directed towards the head of the device and gentle flanks directed towards the base of the device that extend as far as the steep flank of the next annular rib and are spaced axially along the length of the device, and the device being manufactured from an absorbable material in view of Overaker in order to to serve as a receiving surface for the insertion of an expander member (column 3 lines 4-11), for engaging the bone tissue within a bone opening (column 3 lines 18-25), and to act as a therapeutic agent release matrix (column 6 lines 62-67, column 7 lines 1-67, and column 8 lines 1-16).

Allowable Subject Matter

7. Claims 11-15 are allowed.
8. Claims 3-5, 8, and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 1, 2, 6, 7, and 10 have been considered but are moot in view of the new ground(s) of rejection. The examiner has made a new grounds of rejection using new reference West JR (U.S. Publication 2003/0074002) that teaches of an anchoring device having a beveled

Art Unit: 3733

surface on the head of the device as discussed above. When combined with the previous references of Tabor and Overaker, claims 1, 2, 6, 7, and 10 can still be rejected under 35 U.S.C. 103 as discussed above. The new grounds of rejection are necessitated by the amendments made to claim 1 by the applicant. Before the amendment claim 1 only required the device to have a bevel in the area of the longitudinal slit wherein the bevel decreased in width toward the device. The examiner interpreted Tabor to show a longitudinal slit wherein the slit itself was beveled along the length of the device wherein the width of the bevel decreased from the head towards the base of the device. The claim as amended requires not only an area near the longitudinal slit to have a bevel but also the head part of the device needs to be beveled. Therefore, due to the additional limitation added by the amendment, a new reference needed to be added to teach beveling the head part of the device.

In response to Applicant's argument that Overaker (U.S. Patent 6,942,666) is nonanalogous art, it has been held that the determination that a reference is from a nonanalogous art is twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. In re Wood, 202 USPQ 171, 174. In this case, the applicant discloses a device that is used to anchor element to bones. Overaker also discloses a device that is used to anchor elements to bones. Therefore, Overaker is not non-analogous art because both devices solve a similar problem.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

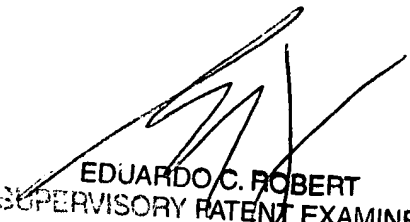
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The

Art Unit: 3733

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NWW


EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER